

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 16-26, 28-35, 37, and 39-50 are pending in the application, with claims 16 and 28 being the independent claims. Claims 16 and 28 have been amended to clarify the features that comprise Applicant's invention. Claims 20 and 32 have been amended solely to overcome the Examiner's rejection under 35 U.S.C. §112, first paragraph. Claims 47 and 48 have been amended solely to correct their dependency. These changes are believed to introduce no new matter and their entry is respectfully requested.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Information Disclosure Statement

The Examiner alleges that

The information disclosure statement (IDS) filed August 9, 2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because applicant states that "However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated" - see second paragraph of the front page of the IDS. Such statement suggests that the dates may not be valid, and therefore does not comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any resubmission of any item of information contained in this IDS or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a). [Emphasis in original.]

Office Action, p. 4.

Applicant submits that none of 37 CFR §§1.97 or 1.98 or MPEP §609 addresses the Examiner's objected to statement. There is nothing in either rule or in the MPEP section that mentions anything about admitting an actual date of publication where the document submitted contains a publication date. In making his submission, Applicant acknowledges that the several documents are dated. Applicant cannot guarantee that the documents were in fact made publicly available as of their stated publication dates. The Examiner is free to use the indicated publication dates as an effective date of the documents as references. Applicant reserves the right to challenge any stated publication date should it become necessary or desirable to do so.

Applicant has clearly satisfied the requirements of 37 CFR 1.97 and 1.98 and MPEP §609. Except as noted below, Applicant requests that the Examiner review the documents identified in the IDS on their merits in connection with the claims of this application. If the Examiner continues to object to the Information Disclosure Statement on this basis, it is requested that he point out with particularity which part of either the CFR or MPEP sections has not been met.

The Examiner further states that

numerous references listed on the information disclosure statement (IDS) filed August 9, 2007 were previously considered by the examiner. Applicant needs to submit IDS listing only references not previously considered or not previously cited by the examiner. A submission of IDS that includes references previously considered or cited would increase the burden of examination because the examiner has to find out which of the references not to consider, or inadvertently consider the previously considered or cited references again.

Office Action, pp. 4-5.

Applicant points out that only the following references cited in the IDS of August 9, 2007 had been submitted in previous IDS 's in this application:

US 172
US 174
US 175
US 176
NPL218
NPL219
NPL220
NPL221
NPL222

To the extent the Examiner has previously considered these references, Applicant does not expect the Examiner to again review them.

The majority of the references submitted in the IDS of August 9, 2007 were brought to Applicant's attention by defendants during the course of two litigations, namely

Teleshuttle Technologies, L.L.C. et al v. Microsoft Corporation, U.S.D.C. ND CA
CIVIL CASE #: 5:04-cv-02927-JW

Teleshuttle Technologies, L.L.C. et al v. Microsoft Corporation et al, U.S.D.C. ND
CA CIVIL CASE #: 5:04-cv-02928-JW.

Others of the listed documents were cited by Examiners in Applicant's related applications.

The documents submitted in the IDS of August 9, 2007 were presented out of an abundance of caution. Applicant does not assert that either he or his representatives have reviewed each listed document in detail in connection with the herein claimed invention. Applicant is not aware that any of the listed documents are more material to the claims of this application than are the references that have already been considered by the Examiner.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 16-26, 28-35, 37, and 39-50 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

The Examiner argues that

the specification, while being enabling for "receiving at the user station an information object containing a schedule to monitor a broadcast data stream", does not reasonably provide enablement for "receiving at the user station an information object containing a schedule to cause the user station to watch for at least one desired data object in a broadcast data stream". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. Note that a schedule alone cannot cause the user station to watch for at least one desired data object in a broadcast data stream.

Office Action, pp 4-5.

Independent Claims 16 and 28 have been amended to clarify the features of the claimed subject matter. Specifically, claim 16 has been amended to recite

the user station watching for at least one desired data object in a broadcast data stream based on the schedule in the CIP, the at least one desired data object being identified in the broadcast data stream by an object identifier contained in the broadcast data stream. . . .

Analogously, claim 28 has been amended to recite

logic at the user station for enabling the user station to watch for at least one desired data object in a broadcast data stream based on the schedule in the CIP, the at least one desired data object being identified in the broadcast data stream by an object identifier contained in the broadcast data stream

The specification clearly supports the features recited above, to wit:

Broadcasting can be airwave broadcasting via satellite, FM, or TV subchannels in the manner, for example, used by Mainstream Data Ltd. for the broadcast of news wires. Alternatively, the broadcast data stream may be cable or line transmitted, for example, over cable television systems. Minor extensions to API's 40 and 42 could accommodate such a facility. A modified setup function could alert a user's receiving communications device to watch for receipt of data objects identified as relating to the original or containing information product, and to capture and hold identified objects in temporary

storage. A schedule transport function can then be set to fetch the received data objects from temporary storage and prepare them for use.

Specification, p. 39., lines 1-9.

Additional support is found at page 8, lines 10-12, where a method is described that "...a **user station**...automatically monitors a data stream...", where "...data **information objects** are contained within a **broadcast data stream**...", and the data objects themselves are "...identified as relating to the...**containing information product**...", as described in the specification on page 38, lines 24-25, and page 39, lines 5-6.

Claims 20-21, 25, and 32 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Without acquiescing in the correctness of the Examiner's rejection, Applicant has amended claims 20, 21, and 32 to clearly define the claimed subject matter consistent with the specification. On this basis, Applicant respectfully traverses this rejection.

The Examiner apparently alleges that the following claimed features are not described in the specification:

"selecting the first one of the plurality of independently operated data sources from a listing of each of the plurality of independently operated data sources" - as recited in claims 20-21, 32;

"wherein the method is performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed" - as recited in claim 25. . . .

Office Action, p. 5.

The features recited in one or more of Claims 20, 21, 25 and 32 are clearly supported by the specification:

According to one aspect, the present invention provides software stored on a computer-readable storage medium at a user station that is configured for communications with a multiplicity of independently-operated data sources via a non-proprietary network. Preferably, the software includes a monitor function that automatically monitors a data stream supplied by a selected one of the data sources to identify receipt of desired data, and a capture function that automatically captures the desired data identified by the monitor function, wherein the data stream includes both the desired data and other data.

Page 8, lines 9-14.

The transporter can be repeatedly reactivated on an as-needed basis to provide intermittent communication with the remote server or servers specified or user-entered in its setup protocols, thereby simulating the ongoing, open-ended interactivity of an online connection with the remote server. Naturally, the Web site sponsor may choose to modify the local pages as compared with their Web site counterparts, for example to simplify them, or to provide access to content or function intended by the sponsor for local use only.

Page 65, lines 19-25.

[L]ocal Web content can be pre-distributed on CD-ROM or diskette for use with the described offline browser system. This distributed, locally stored Web content can then be combined with more current, or additional content obtained from the sponsor's Web site or other remote location by either intermittent shuttling or live continuous browsing. This allows user selection of local, intermittent or live modes, as desired, or as available at any given time and place. Providing such multiple access capabilities enables a vendor or sponsor to distribute their product en masse to computer owners or users with confidence that a large number of prospects can use the product easily and currently. For example, diskettes might be given away with a computer magazine to be sure of reaching a market rich in enabled prospects by any vendor willing to make the investment to reach them. A different group are prospective house purchasers, a group rich in computer owners and users, who could be given an initial diskette or CD-ROM containing a realtor's listings, and the inventive offline browser system for viewing and updating the listings from a Web site or other remote server using either the Internet or the telephone network. This method enables the prospects to browse the realtor's listings offline at their leisure, and to update it easily via either the Internet or the telephone network, as needed. The realtor does not have to consider whether their prospect has an Internet access subscription, and the prospect does not have to worry about the difficulties and costs of attempting to download extensive listings.

Page 66, line 15 - page 67, line 3

For smooth and efficient integration of the offline Web browser system with online browsing activity, it is desirable for the offline browser automatically to access the most up-to-date version of any particular content element, and if it

must be retrieved from a remote source to be able to fetch it either via live browsing or by shuttle mode. Preferably, the local browser should fetch content from the network only if a local copy is no longer current. This capability requires a mechanism to check time stamps of both network and local copies. More advanced embodiments could use more complex and variable criteria for this decision, such as factors for file size, type, urgency, and connection availability, as well as relative currency.

Page 72, lines 7-14.

For the above reasons, and in light of the foregoing amendments, Applicant respectfully requests that the Examiner reconsider and withdraw his rejections under 35 U.S.C. §112, first paragraph.

Rejections under 35 U.S.C. §112, second paragraph

Claims 16-26, 28-35, 37, and 39-50 have been rejected under U.S.C. §112, second paragraph, as being allegedly "incomplete for omitting essential elements/steps, such omissions amounting to a gap between the elements." Without acquiescing in the correctness of the rejection, Applicant has amended claims 16 and 28 to further clearly define the claimed subject matter. On this basis, Applicant respectfully traverses this rejection.

Claims 47-48 have been again rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The Examiner contends that there is insufficient antecedent basis for the respective limitations in the respective claims. This ground of rejection is still not understood. Claim 28 clearly recites "**logic** at the user station **for capturing and storing** the at least one desired data object from the received broadcast data stream...." Claims 47 and 48 further define the "...logic for capturing and storing..." recited in Claims 28, from which claims 47 and 48 directly depend. Applicant does not understand how the antecedent basis for the recited elements is insufficient. The Examiner has not explained the basis for his rejection, as was previously requested by Applicant. Without such explanation, Applicant cannot effectively respond.

Rejections under 35 U.S.C. § 103

Claims 16-26, 28-35, 37, 39-42, and 39-50 have been rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Young, U.S. Patent No. 4,706,121, in view of Joseph et al., U.S. Patent No. 5,819,034, ("Joseph"). Applicant respectfully traverses this rejection.

The Examiner alleges that

As per claim 1, [sic] Young teaches a method for operating a user station [Abstract],

comprising:

receiving at the user station an information object containing a schedule [user setting the schedule - Abstract, lines 5-10] to cause the user station to watch for at least one desired data object in a broadcast data stream [Abstract, lines 10-15];

receiving the broadcast data stream [135, FIG. 2]; and

capturing and storing the at least one desired data object from the received broadcast data stream based on information in a containing information product [schedule information from FM receiver - Abstract, line 4] and on the schedule [Abstract, lines 15-17].

Young does not specifically teach capturing and storing the at least one desired data object identified in the broadcast data stream based on an object identifier contained in the broadcast data stream.

Office Action, pp. 6-7 (Emphasis in original).

Although the Examiner references claim 1 in his rejection, it is assumed that the reference was intended to be to Claim 16. Applicant will respond on the basis of that assumption.

The Examiner alleges that Young teaches each element recited in Claim 16, save one. The Examiner acknowledges that Young does not teach "capturing and storing the at least one desired data object identified in the broadcast data stream based on an object identifier contained in the broadcast data stream." The Examiner relies on Joseph for allegedly teaching this missing element.

Applicant respectfully disagrees with the Examiner's position. Young does not teach or suggest the features recited in Claim 16. Young is directed to transmitting television broadcast signals, including schedule information relating to the programming that is being transmitted. Young does not teach or suggest "receiving at the user station a schedule in a containing information product (CIP)," and separately "receiving a broadcast data stream containing at least one desired data object, the at least one desired data object being identified in the broadcast data stream by an object identifier contained in the broadcast data stream."

Nor does Young teach or suggest

comparing the at least one desired data object to a data object previously received and stored at the user station; [and]

determining whether the at least one desired data object contains newer data than the previously stored data object.

Young's disclosure is focused on recording TV signals from over the air broadcasts. The "schedule" in Young's disclosure is a continuously downloaded TV guide schedule. The schedule is an FM signal transmitted on an unused portion of a TV signal. ('121 patent, Col. 7, lines 1-5.) Young nowhere compares the incoming data object with a previously stored data object and only captures and stores the newly received data object if the new data object contains newer data than the previously stored object. No such comparison is made by Young.

Still further, Young does not teach or suggest "capturing and storing the at least one desired data object from the received broadcast data stream based on the information in the CIP, including the schedule in the CIP, and on the at least one desired data object's object identifier contained in the broadcast data stream" *only if the desired data object contains newer data.*

Joseph does not teach or suggest "receiving at the user station a schedule in a containing information product (CIP)." On the contrary, Joseph teaches "a source of a continuous data stream repetitively transferring [sic] data representing a distributed computing application and a client computer, receiving the data stream, for extracting the distributed computing application representative data from the data stream, and executing the extracted distributed computing application." (Joseph, Abstract; *see also* Col. 3, lines 13-15; Col 4, lines 60-65; Col. 5, lines 29-31; and Col. 5, lines 48-51.)

Like Young, Joseph does not teach the steps of

comparing the at least one desired data object to a data object previously received and stored at the user station; [and]

determining whether the at least one desired data object contains newer data than the previously stored data object.

There is nothing in Joseph that teaches or suggests a comparison that is anything like that claimed herein.

Claim 28 recites similar features as those of claim 16 discussed in detail above. The arguments distinguishing claim 16 from the combination of Young and Joseph are equally applicable to claim 28.

For reasons set forth above, it is clear that Young and Joseph cannot be combined in any rational manner to render obvious the invention recited in independent claims 16 and 28. For at least these reasons, independent claims 16 and 28, and their respective dependent claims 17-26 and 29-35, 37, 39-42, and 39-50 are patentable over the combination of Young and Joseph. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

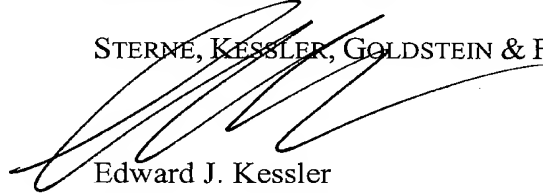
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read 'Edward J. Kessler', is written over the printed name and firm name.

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